

REMARKS

Claims 1-28 are now pending in the application. New Claim 29 has been added. Claims 1-19 currently stand rejected. Claims 20-28 have been allowed. The Examiner is respectfully requested to reconsider and withdraw the rejection(s) in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 102

Claims 1-15 and 18 currently stand rejected under 35 U.S.C. § 102(b) as being anticipated by Morrison et al. (U.S. Pat. No.5,082,789). In this regard the Examiner suggests that Morrison et al teaches a thin film gas sensor for detecting alcohols, specifically ethanol in breath samples. The gas sensors use said comprise bismuth molybdate deposited onto a thin film substrate with electrical contacts deposited onto the substrate. With respect to the method of preparing gas sensors, Morrison et al is said to teach depositing a precursor solution of bismuth molybdate solution in a 1:1 ratio. The powder was melted and vacuum evaporated onto a quartz substrate until a thin film was formed. The film was calcined at a temperature of 400°C. Next, gold electrical contacts were applied by evaporation onto the substrate. See Examples 1 and 2.

The Examiner therefore concludes that Applicant's claimed invention is deemed to be anticipated, within the meaning of 35 USC 102 in view of the teachings of Morrison et al.

This rejection is respectfully traversed.

As the Examiner is well aware, a rejection under 35 U.S.C. §102(b) can only be maintained if a single reference teaches each and every element of the claims. If there are any differences whatsoever between the reference and the claim(s), the rejection cannot be based on 35 U.S.C. §102. Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

As amended, claims 1 and 12 now specifically recite the composition of the bismuth molybdate employed. In view of this limitation, Applicant respectfully submits that the rejection under §102(b) is moot since the prior art of record fails to teach each and every element of the claims as amended. Additionally, since claims 2-11 and 13-19 ultimately depend from claims 1 and 12 respectfully, the rejection of these claims should also be moot.

REJECTION UNDER 35 U.S.C. § 103

Claims 16, 17 and 19 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Morrison et al in view of Kobayashi et al. (U.S. Pat. No.5,252,140). In this regard the Examiner notes that with respect to claims 16, 17 and 19, Morrison et al differs from the instantly claimed invention in that there is no teaching of spray pyrolysis or thermal evaporation for depositing the thin film or electrode.

Kobayashi et al teach that spray pyrolysis and thermal evaporation are conventional methods for depositing film layers onto thin film devices, where the substrate is glass or silica. The Examiner suggests that it would have been obvious to one of ordinary skill in the art to use any known deposition method, such as a spray

pyrolysis or thermal evaporation to deposit the thin film onto the substrate in Morrison et al.

This rejection is respectfully traversed.

In order to support a rejection under 35 U.S.C. §103, the Examiner must establish that there is some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability, and, thus, the obviousness, of making the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988). That is, although the Examiner may suggest that the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the *desirability* of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir. 1989).

As noted above, Applicant has amended claim 12 to specifically recite the composition of the bismuth molybdate. In view of this amendment, Applicant respectfully submits that the rejection under 35 USC §103(a) should now be moot.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office

Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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